

REMARKS

Claims 5, 16 and 17 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 16 and 17 are objected to under 37 C.F.R. 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claims 8-12, 15 and 17-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of four references, namely Great Britain '870 in view of Japan '104, Europe '137 and Sandstrom, et al. (U.S. 5,216,066). Additionally, claims 5 and 16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of five references, namely Great Britain '870, Japan '104, Europe '137 and Sandstrom, et al., further in view of Kirk-Othmer. The allowance of claims 5 and 16 is withdrawn in view of the Kirk-Othmer reference.

The Rejections Under 35 U.S.C. 112

Applicant respectfully requests that the rejection under 35 U.S.C. 112 be withdrawn in view of the amendments presented herein. In particular, the spelling of wax in Claim 5 is corrected herein. Claim 16 is cancelled, and the dependency of Claim 17 has been corrected.

The Rejections Under 35 U.S.C. 103(a)

Applicant respectfully requests reconsideration of the rejections under 35 U.S.C. 103(a). Applicant respectfully submits that the combination of references on which the rejections are based do not teach the combination of components comprising Applicant's non-marking tread cap as recited in Claim 5, and further does not teach the ranges of the components comprising the tread cap as recited in Claim 8.

The rejections are based on a combination of four references in regards to claim 8 and five references in regards to Claim 5. The references when considered as a whole teach inconsistent tread compositions, and inconsistent ranges or amounts of components comprising the tread composition. There is no citation in the Office Action to any teaching in any of the references to select one component or ingredient over another, and particularly to select one range or amount of an ingredient over another.

GB '870, for example, does not teach or suggest all of the components of Applicant's non-marking tread cap. As non-limiting examples, this reference does not teach the inclusion of ethylene propylene rubber or white carbon, and it only teaches 0-1

pts. carbon black. Japan '104 does not teach the use of ethylene propylene rubber or rubber oil. Nor does it teach the inclusion of polybutadiene rubber in addition to natural and synthetic rubber. Moreover, it only teaches 10 pts. natural and synthetic rubber and 0-1 pts. carbon black. Europe '137, on the other hand, discloses a sulfur-vulcanizable rubber mixture containing no aromatic process oil. See Abstract, line 1. It thus teaches away from Applicant's inclusion of rubber oil in his tread cap composition. Additionally, from the Abstract provided, it does not appear that Europe '137 teaches the use of natural and synthetic rubber in addition to polybutadiene rubber or the use of ethylene propylene rubber in addition to natural and synthetic rubber. Europe '137, therefore, shows that Applicant's claimed tread cap composition is not obvious taken as a whole in combination with the other cited references.

The Kirk-Othmer reference teaches all types of agents. There is no citation in the Office Action to any teaching on how to select some, but not all, of such agents and further how to determine how much of a selected agent to use. For example, none of the references either alone or together teach or suggest a combination of natural and synthetic rubber, ethylene propylene rubber, and polybutadiene rubber. Applicant submits that the teaching or suggestion to make the combination of components in the amount of components recited in Applicant's claims is found only in Applicant's own specification.

The Office Action ignores the inconsistencies in the teachings of the references and thus ignores their teachings as a whole. For example, the references demonstrate an inconsistency as to whether rubber oil should be included. Furthermore, nowhere in the cited references is there any teaching or suggestion of rubber oil in the amount of 7.5-12.5. As another example, while the Office Action takes the position that a 1:1 ratio of carbon black to white carbon would be obvious in view of Europe '137, it ignores the teachings of JP '104 that teaches 30-70 pts silica and 0-1 pts carbon black and also the teachings of GB '870 which teaches 75 pts carbon black and no silica.

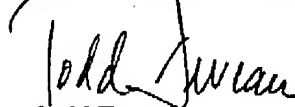
The basis of the rejection of Claims 5 and 8 in the Office Action amounts to an "obvious to try" basis. More particularly, the rejection, in effect, takes the position it would have been "obvious to try" to vary all parameters or to try each of the numerous possible choices until one possibly arrived at Applicant's result, where there is no citation in the Office Action to any teaching or suggestion in the prior art providing an indication

of which parameters should be tried and the direction as to which any one or more of the many possible choices is likely to be successful. This type of rejection is not an appropriate basis for rejecting Applicant's claims.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant submits that the remaining claims of this application are now in condition for allowance and such action is respectfully solicited.

Respectfully submitted,



Todd Deveau

**THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.**

100 Galleria Parkway, NW, Suite 1750
Atlanta, Georgia 30339
Phone: 770.933.9500
E-mail: todd.deveau@tkhr.com